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EXAMINER	
DWIVEDI, MAHESH H	
ART UNIT	**PAPER NUMBER**
2168	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/709,793	ANDRA ET AL.	
	Examiner	Art Unit	
	Mahesh H. Dwivedi	2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 November 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,8-16 and 18-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6, 8-16, and 18-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 May 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 09/16/2004 has been received, entered into the record, and considered. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Amendment

2. Receipt of Applicant's Amendment, filed on 11/16/2006, is acknowledged. The amendment includes the amending of the specification, the cancellation of claims 7 & 17, the addition of claims 23-24, and the amending of claims 1, 5, 6, 11, 15, 19, & 21-22.

Drawings

3. The objections raised in the office action mailed on 08/22/2006 have been overcome by the applicant's amendments received on 11/16/2006.

Claim Rejections - 35 USC § 112

4. The objections raised in the office action mailed on 08/22/2006 have been overcome by the applicant's arguments and amendments received on 11/16/2006.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-6, 8-16, and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dan et al.** (U.S. PGPUB 2002/0178103), and in view of **Thomas** (U.S. PGPUB 2003/0167446).

7. Regarding claims 1 and 11, **Dan** teaches a method and a program storage device comprising:

A) establishing an original pre-defined data type definition format for an XML transaction (Paragraphs 31, 50, &58, Figures 8-9);

C) pre-building static structures of said XML transaction (Paragraphs 33-35);

D) classifying dynamic structures of said XML transaction with empty tags and single occurrence classifiers for repeating dynamic structures (Paragraphs 34-35);

E) building a list of a sequence of said static and dynamic structures (Paragraph 32);

F) linking said list to a type of XML transaction and a predetermined trading partner profile (Paragraphs 5, 32-34); and

G) combining said static structures with said dynamic structures at a runtime of said XML transaction based on said sequence, said type of XML transaction, said trading partner profile, and said dynamic structures of said XML transaction (Paragraphs 34-35).

H) wherein an occurrence of said runtime of said XML transaction occurs when said XML transaction occurs when said XML transaction is sent to a trading partner (Paragraphs 33-34, 36); and

I) constructing a final XML structure based on the combining process (Paragraph 46).

The examiner notes that **Dan** teaches **"establishing an original pre-defined data type definition format for an XML transaction"** as "According to the invention, a meta-contract governs or controls the negotiation process. The meta contract is either pre-negotiated or formed from information provided by the parties in one or more electronic documents, preferably in the form of profiles, described in greater detail below... Before creating a meta-contract, the parties must first accept a negotiation protocol to be used during the negotiation process. After the parties accept the negotiation protocol, a meta-contract may be formed and the parties may begin a negotiation" (Paragraph 31), "FIG. 8 illustrates the preferred data type definition (DTD) covering all offer documents" (Paragraph 50), and "FIG. 9 illustrates the preferred data type definition (DTD) covering all counter offer documents" (Paragraph 58). The examiner further notes that **Dan** teaches **"pre-building static structures of said XML**

transaction" as "The profile serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further notes that **Dan** teaches **"classifying dynamic structures of said XML transaction with empty tags and single occurrence classifiers for repeating dynamic structures"** as "a negotiable field 1023 or 1024 may be treated as a blank that me be completed by the negotiating party" (Paragraph 35). The examiner further notes that **Dan** teaches **"building a list of a sequence of said static and dynamic structures"** as "a set of sequencing rules 180 may be provided in meta contract 110 to ensure that the various negotiation actions are being issued in the correct order" (Paragraph 32). The examiner further notes that **Dan** teaches **"linking said list to a type of XML transaction and a predetermined trading partner profile"** as "The general information about the TPA provides the TPA name, its type and its version. The roles and the participants section specifies the various roles and participants along with the contact information of the business partners, and it also includes the valid duration of the contract, the number of times the contract may be used and how often it may be invoked" (Paragraph 5) and "Starting definitions and values for these types of information in the negotiated contract may be provided in a TPA template or party profile" (Paragraph 32). The examiner further notes that **Dan** teaches **"combining said static structures with said dynamic structures at a runtime of said XML**

transaction based on said sequence, said type of XML transaction, said trading partner profile, and said dynamic structures of said XML transaction" as "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further notes that once the contract template of **Dan** is sent for negotiation, it contains fields that are set and non-negotiable and fields that are not set and are negotiable. The examiner further notes that **Dan** teaches **"wherein an occurrence of said runtime of said XML transaction occurs when said XML transaction occurs when said XML transaction is sent to a trading partner"** as "The profile serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further wishes to state that the initial contract must combine the static fields (almost complete portions) and dynamic fields (the blank portions) at runtime (when the contract is sent to other party). The examiner further notes that **Dan** teaches **"constructing a final XML structure based on the combining process"** as "the negotiation continues 370 to step 380 where the negotiation is complete and step 390 leads to the service contract or TPA" (Paragraph 46).

Dan does not explicitly teach:

B) creating a copy of said original pre-defined data type definition format for said XML transaction; and

J) wherein said final XML structure is validated by comparing said final XML structure against said copy of said original data type definition format for said XML transaction. **Thomas**, however, teaches "**creating a copy of said original pre-defined data type definition format for said XML transaction**" as "the processor reads 12 the document type definition (DTD) of the first XML file and creates a copy 13 of the DTD" (Paragraph 38) and "**wherein said final XML structure is validated by comparing said final XML structure against said copy of said original data type definition format for said XML transaction**" as "Once the user has finished entering modifications to the XML file and all of the modifications have been found to be either not significant or valid semantic changes, the temporary version of the XML file in the RAM 7 is written over the original XML file in the first storage region 4" (Paragraph 44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Thomas's** would have allowed **Dan's** to provide a method to record changes to a markup language file by validating them in order to allow that file to be in compliance with constraints defined in a set of declarations, as noted by **Thomas** (Paragraph 5).

Regarding claims 2 and 12, **Dan** further teaches a method and program storage device comprising:

A) wherein said XML transaction occurs in a business-to-business (B2B) electronic environment (Paragraph 29).

The examiner notes that **Dan** teaches **"wherein said XML transaction occurs in a business-to-business (B2B) electronic environment"** as "method of automated negotiations of the invention is capable of producing a contract such as, for example, a service contract, and preferable a business-to-business (B-B) service contract" (Paragraph 29).

Regarding claims 3 and 13, **Dan** further teaches a method and program storage device comprising:

A) predefining said trading partner profile associated with a predetermined trading entity (Paragraph 38).

The examiner notes that **Dan** teaches **"predefining said trading partner profile associated with a predetermined trading entity"** as "when each of the parties has a preexisting profile, an initial version of a contract may be created by automatically combining information from the profiles, subject to a later negotiation process" (Paragraph 38).

Regarding claims 4 and 14, **Dan** further teaches a method and program storage device comprising:

A) wherein said pre-building of said static structures occurs prior to runtime of said XML transaction (Paragraphs 33-34).

The examiner notes that **Dan** teaches **"wherein said pre-building of said static structures occurs prior to runtime of said XML transaction"** as "The profile

serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further notes that contract of **Dan's** runs once the negotiation phase begins to fill in the initial blank negotiable fields 1023 and 1024.

Regarding claims 5 and 15, **Dan** does not explicitly teach a method and program storage device comprising:

A) wherein the construction of said final XML structure follows definition established by said copy of said original data type definition format for said XML transaction.

Thomas, however teaches "wherein the construction of said final XML structure follows definition established by said copy of said original data type definition format for said XML transaction" as "The XML file is read and a temporary copy made and stored 28 in the RAM 7. The temporary copy of the contents of the XML file is displayed 29 by means of the output interface 10 so that a user is able to input modifications to the XML file via the input interface 9... Once the user has finished entering modifications to the XML file and all of the modifications have been found to be either not significant or valid semantic changes, the temporary version of the XML file in the RAM 7 is written over the original XML file in the first storage region 4. Of course, the modified version of the

XML file may be stored separately from the original version of the XML file instead of overwriting the original XML version" (Paragraphs 43-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Thomas's** would have allowed **Dan's** to provide a method to record changes to a markup language file by validating them in order to allow that file to be in compliance with constraints defined in a set of declarations, as noted by **Thomas** (Paragraph 5).

Regarding claims 6 and 16, **Dan** further teaches a method and program storage device comprising:

A) filling said empty tags of said dynamic structures with business data values (Paragraphs 34-35); and

B) building multiple repeating dynamic structures at runtime of said XML transaction (Paragraphs 34-35, 44).

The examiner notes that **Dan** teaches **"filling said empty tags of said dynamic structures with business data values"** as "a negotiable field 1023 or 1024 may be treated as a blank that may be completed by the negotiating party" (Paragraph 35) and **"building multiple repeating dynamic structures at runtime of said XML transaction"** as "A negotiation comprises one or more sub negotiations. Each sub negotiation involves a subset of all of the items to be negotiated" (Paragraph 44).

Regarding claims 8 and 18, **Dan** further teaches a method and program storage device comprising:

A) wherein said trading partner profile comprises partner data, communication protocol data, transaction data, transaction format data, and XML format version data (Paragraphs 33-35, Figure 4).

The examiner notes that **Dan** teaches **"wherein said trading partner profile comprises partner data, communication protocol data, transaction data, transaction format data, and XML format version data"** as "The profile may include information such as: products and services provided, specific business processes that the service provider can perform, security requirements, and technology information such as which message-exchange protocols are supported by the service provider" (Paragraph 33) and "Allowable choices 1014 may cover, for example, business and/or technical considerations such as a list of supported transport protocols, a list of supported shipping and transport services (such as overnight shipping, airmail delivery, etc.), delivery times, and/or the optional use of preexisting meta contract" (Paragraph 35).

Regarding claims 9 and 19, **Dan** further teaches a method and program storage device comprising:

A) wherein said pre-building of said static structures and a pre-building of said dynamic structures occurs at a time of installation of said trading partner profile in a database in said computer system (Paragraph 10).

The examiner notes that **Dan** teaches **"wherein said pre-building of said static structures and a pre-building of said dynamic structures occurs at a time of installation of said trading partner profile in a database in said computer system"** as "providing a starting state for a contract, wherein the starting state may be a previous contract, a publicly defined template such as, for example, Open Buying on the Internet (OBI), or a template defined prior to the negotiation by one of the parties" (Paragraph 10).

Regarding claims 10 and 20, **Dan** further teaches a method and program storage device comprising:

A) linking said static structures to a type of XML transaction and said predetermined trading partner profile (Paragraphs 32-34); and

B) storing the linked static structures in said database (Paragraph 37).

The examiner notes that **Dan** teaches **"linking said static structures to a type of XML transaction and said predetermined trading partner profile"** as "Starting definitions and values for these types of information in the negotiated contract may be provided in a TPA template or party profile" (Paragraph 32) and **"storing the linked static structures in said database"** as "In a preferred embodiment of the invention, an initial version of a contract may be obtained from a repository that contains a collection of searchable information, including individual businesses' contract templates or profiles and other related information" (Paragraph 37).

Regarding claim 21, **Dan** teaches a computer system comprising:

A) means for establishing an original pre-defined data type definition format for an XML transaction (Paragraphs 31, 50, &58, Figures 8-9);

C) means for pre-building static structures of said XML transaction (Paragraphs 33-35);

D) means for classifying dynamic structures of said XML transaction with empty tags and single occurrence classifiers for repeating dynamic structures (Paragraphs 34-35);

E) means for building a list of a sequence of said static and dynamic structures (Paragraph 32);

F) means for linking said list to a type of XML transaction and a predetermined trading partner profile (Paragraphs 5, 33-34); and

G) means for combining said static structures with said dynamic structures at a runtime of said XML transaction based on said sequence, said type of XML transaction, said trading partner profile, and said dynamic structures of said XML transaction (Paragraphs 34-35);

H) wherein an occurrence of said runtime of said XML transaction occurs when said XML transaction occurs when said XML transaction is sent to a trading partner (Paragraphs 33-34, 36); and

I) means for constructing a final XML structure based on the combining process (Paragraph 46).

The examiner notes that **Dan** teaches **"establishing an original pre-defined data type definition format for an XML transaction"** as "According to the invention, a meta-contract governs or controls the negotiation process. The meta contract is either

pre-negotiated or formed from information provided by the parties in one or more electronic documents, preferably in the form of profiles, described in greater detail below... Before creating a meta-contract, the parties must first accept a negotiation protocol to be used during the negotiation process. After the parties accept the negotiation protocol, a meta-contract may be formed and the parties may begin a negotiation" (Paragraph 31), "FIG. 8 illustrates the preferred data type definition (DTD) covering all offer documents" (Paragraph 50), and "FIG. 9 illustrates the preferred data type definition (DTD) covering all counter offer documents" (Paragraph 58). The examiner further notes that **Dan** teaches **"means for pre-building static structures of said XML transaction"** as "The profile serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further notes that **Dan** teaches **"means for classifying dynamic structures of said XML transaction with empty tags and single occurrence classifiers for repeating dynamic structures"** as "a negotiable field 1023 or 1024 may be treated as a blank that me be completed by the negotiating party" (Paragraph 35). The examiner further notes that **Dan** teaches **"means for building a list of a sequence of said static and dynamic structures"** as "a set of sequencing rules 180 may be provided in meta contract 110 to ensure that the various negotiation actions are being issued in the correct order" (Paragraph 32). The examiner further notes that **Dan** teaches **"means**

for linking said list to a type of XML transaction and a predetermined trading partner profile" as "The general information about the TPA provides the TPA name, its type and its version. The roles and the participants section specifies the various roles and participants along with the contact information of the business partners, and it also includes the valid duration of the contract, the number of times the contract may be used and how often it may be invoked" (Paragraph 5) and "Starting definitions and values for these types of information in the negotiated contract may be provided in a TPA template or party profile" (Paragraph 32). The examiner further notes that **Dan** teaches **"means for combining said static structures with said dynamic structures at a runtime of said XML transaction based on said sequence, said type of XML transaction, said trading partner profile, and said dynamic structures of said XML transaction"** as "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further notes that once the contract template of **Dan** is sent for negotiation, it contains fields that are set and non-negotiable and fields that are not set and are negotiable. The examiner further notes that **Dan** teaches **"wherein an occurrence of said runtime of said XML transaction occurs when said XML transaction occurs when said XML transaction is sent to a trading partner"** as "The profile serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank"

(Paragraph 34). The examiner further wishes to state that the initial contract must combine the static fields (almost complete portions) and dynamic fields (the blank portions) at runtime (when the contract is sent to other party). The examiner further notes that **Dan** teaches **"means for constructing a final XML structure based on the combining process"** as "the negotiation continues 370 to step 380 where the negotiation is complete and step 390 leads to the service contract or TPA" (Paragraph 46).

Dan does not explicitly teach:

B) means for creating a copy of said original pre-defined data type definition format for said XML transaction; and

J) wherein said final XML structure is validated by comparing said final XML structure against said copy of said original data type definition format for said XML transaction.

Thomas, however, teaches **"means for creating a copy of said original pre-defined data type definition format for said XML transaction"** as "the processor reads 12 the document type definition (DTD) of the first XML file and creates a copy 13 of the DTD" (Paragraph 38) and **"wherein said final XML structure is validated by comparing said final XML structure against said copy of said original data type definition format for said XML transaction"** as "Once the user has finished entering modifications to the XML file and all of the modifications have been found to be either not significant or valid semantic changes, the temporary version of the XML file in the RAM 7 is written over the original XML file in the first storage region 4" (Paragraph 44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references because teaching **Thomas's** would have allowed **Dan's** to provide a method to record changes to a markup language file by validating them in order to allow that file to be in compliance with constraints defined in a set of declarations, as noted by **Thomas** (Paragraph 5).

Regarding claim 22, **Dan** teaches a computer system comprising:

A) means for predefining said trading partner profile associated with a predetermined trading entity (Paragraph 38);

B) means for filling said empty tags of said dynamic structures with business data values(Paragraphs 34-35); and

C) building multiple repeating dynamic structures at runtime of said XML transaction (Paragraphs 34-35, 44);

D) means for linking said static structures to a type of XML transaction and said predetermined trading partner profile (Paragraphs 5, and 32-34); and

E) means for storing the linked static structures (Paragraph 37).

The examiner notes that **Dan** teaches **"means for predefining said trading partner profile associated with a predetermined trading entity"** as "when each of the parties has a preexisting profile, an initial version of a contract may be created by automatically combining information from the profiles, subject to a later negotiation process" (Paragraph 38), **"means for filling said empty tags of said dynamic structures with business data values"** as "a negotiable field 1023 or 1024 may be

treated as a blank that may be completed by the negotiating party" (Paragraph 35), **"building multiple repeating dynamic structures at runtime of said XML transaction"** as "A negotiation comprises one or more sub negotiations. Each sub negotiation involves a subset of all of the items to be negotiated" (Paragraph 44), **"means for constructing a final XML structure using said means for combining"** as "the negotiation continues 370 to step 380 where the negotiation is complete and step 390 leads to the service contract or TPA" (Paragraph 46), **"means for linking said static structures to a type of XML transaction and said predetermined trading partner profile"** as "The general information about the TPA provides the TPA name, its type and its version. The roles and the participants section specifies the various roles and participants along with the contact information of the business partners, and it also includes the valid duration of the contract, the number of times the contract may be used and how often it may be invoked" (Paragraph 5) and "Starting definitions and values for these types of information in the negotiated contract may be provided in a TPA template or party profile" (Paragraph 32), and **"means for storing the linked static structures"** as "In a preferred embodiment of the invention, an initial version of a contract may be obtained from a repository that contains a collection of searchable information, including individual businesses' contract templates or profiles and other related information" (Paragraph 37).

Regarding claim 23, **Dan** further teaches a computer system comprising:

A) wherein said static structures are pre-built prior to runtime of said XML transaction (Paragraphs 33-34).

The examiner notes that **Dan** teaches **"wherein said static structures are pre-built prior to runtime of said XML transaction"** as "The profile serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further notes that contract of **Dan's** runs once the negotiation phase begins to fill in the initial blank negotiable fields 1023 and 1024.

Regarding claim 24, **Dan** further teaches a computer system comprising:
A) wherein said pre-building of said static structures and said dynamic structures are pre-built at a time of installation of said trading partner profile in a database of said computer system (Paragraph 10).

The examiner notes that **Dan** teaches **"wherein said pre-building of said static structures and said dynamic structures are pre-built at a time of installation of said trading partner profile in a database of said computer system"** as "providing a starting state for a contract, wherein the starting state may be a previous contract, a publicly defined template such as, for example, Open Buying on the Internet (OBI), or a template defined prior to the negotiation by one of the parties" (Paragraph 10).

Response to Arguments

8. Applicant's arguments filed on 11/16/2006 have been fully considered but they are not persuasive.

Applicant goes on to argue on page 22, that **"they would still fail to teach the Applicants' claimed invention because of the occurrence of the time of occurrence of the combining of the static and dynamic structures occurs at the runtime...whereas in Dan this occurs during the contract negotiation"**. However, the examiner wishes to point to Paragraphs 33 and 34 of **Dan** which state "The profile serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further wishes to state that the initial contract must combine the static fields (almost complete portions) and dynamic fields (the blank portions) at runtime (when the contract is sent to other party).

Applicant goes on to argue on page 22, that **"Conversely, in the Applicants' claimed invention the constructed XML is compared to a copy of the pre-established DTD and if there is a difference between the constructed XML and the copy of the pre-established DTD, then the XML is invalidated. Therefore, in the Applicants' invention if a difference exists, then the DTD is not changed, but rather the process is repeated until no change exists"**. However, the examiner

wishes to point to Paragraph 44 of **Thomas** which states "Once the user has finished entering modifications to the XML file and all of the modifications have been found to be either not significant or valid semantic changes, the temporary version of the XML file in the RAM 7 is written over the original XML file in the first storage region 4" (Paragraph 44). Moreover, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "if there is a difference between the constructed XML and the copy of the pre-established DTD, then the XML is invalidated" and "if a difference exists, then the DTD is not changed, but rather the process is repeated until no change exists) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The examiner further wishes to state that there is no limitation claimed as directed towards validating a DTD if there are no differences between the compared DTD's.

Applicant goes on to argue on page 25, that **"The Applicants provide for pre-building of static structures of an XML transaction...However, Dan's approach leads to finalizing the structure of a contract document. Conversely, the Applicants' approach occurs after the structure of the XML is finalized between parties...The template, even if it incorporates an XML, remains as a single structure. Conversely, in the Applicants' approach, the XML is broken down into fragments of several static and dynamic structures"**. However, the examiner wishes to point to Paragraphs 33 and 34 of **Dan** which state "The profile serves as the

starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further wishes to state that the almost complete contract represents the static fields, and that it is clear that are a plurality of static and dynamic fields in **Dan's** method (See Figure 4 of Dan, Negotiable and Non-negotiable fields as an example).

Applicant goes on to argue on page 25, that **"The Applicants provide for classifying the dynamic structures of the XML transaction with empty tags and single occurrence classifiers for repeating dynamic structures...However, Dan's approach shows the method of leaving a few fields blank in a document template, while it is being exchanged between parties...the Applicants provide a mechanism where an entire sub-structure within an XL can be left with empty tags with attributes embedded in the XML itself or as an attribute of the list indicating if the entire structure is a single or repeating occurrence"**. However, the examiner wishes to point to Paragraphs 33 and 34 of **Dan** which state "The profile serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further wishes to

state that the almost complete contract represents the static fields, and that it is clear that are a plurality of static and dynamic fields in **Dan's** method (See Figure 4 of Dan, Negotiable and Non-negotiable fields as an example). The examiner further wishes to state that the initial contract must combine the static fields (almost complete portions) and dynamic fields (the blank portions) at runtime (when the contract is sent to other party). Moreover, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "mechanism where an entire sub-structure within an XL can be left with empty tags with attributes embedded in the XML itself or as an attribute of the list indicating if the entire structure is a single or repeating occurrence") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant goes on to argue on page 26 that **"the Applicants provide building a list of a sequence of static and dynamic structures...the Applicants' list is different from that taught in Dan as described above. Moreover, Dan's use of sequencing rules is fundamentally different than the Applicants' approach"**. However, the examiner wishes to point to Paragraph 32 of **Dan** which states "a set of sequencing rules 180 may be provided in meta contract 110 to ensure that the various negotiation actions are being issued in the correct order" (Paragraph 32). The examiner further wishes to state that **Dan** clearly teaches a types of contract templates. The examiner further wishes to state that the claim limitation merely reads as "building a list

of a sequence of said static and dynamic structures". The examiner further wishes to state that one can broadly interpret "building a sequence" as "sequencing rules" since the sequence claimed in the independent claims is not defined in those claims.

Applicant goes on to argue on pages 26-27, that **"the Applicants provide for linking the list to a type of XML transaction and a predetermined trading partner profile...the Applicants' approach links the list of static and dynamic parts to the defined Trading Partner Profile and specific transaction type...Dan does not and cannot accomplish this"**. However, the examiner wishes to point to Paragraph 5 of **Dan** which states "The general information about the TPA provides the TPA name, its type and its version. The roles and the participants section specifies the various roles and participants along with the contact information of the business partners, and it also includes the valid duration of the contract, the number of times the contract may be used and how often it may be invoked" (Paragraph 5). The examiner further wishes to state that **Dan** clearly teaches a types of contract templates.

Applicant goes on to argue on page 27, that **"the Applicants provide for combining the static structures with the dynamic structures at a runtime of the XML transaction based on the sequence, the type of XML transaction, the partner profile, and the dynamic structures of the XML transaction...Dan does not teach how to dynamically fill values in an XML to construct a complete XML prior to transmission"**. However, the examiner wishes to point to Paragraph 34 of **Dan** which states "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further notes that

once the contract template of **Dan** is sent for negotiation, it contains fields that are set and non-negotiable and fields that are not set and are negotiable. Moreover, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "dynamically fill values in an XML to construct a complete XML prior to transmission") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant goes on to argue on page 28, that **"the Applicants provide for pre-building of the static structures to occur prior to runtime of the XML transactions...Dan does not teach how to break an XML transaction and classify the static components...The second phase occurs every time a transaction is sent to a partner, wherein the static structures are combined with the dynamic structures"**. However, the examiner wishes to point to Paragraphs 33 and 34 of **Dan** which state "The profile serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further wishes to state that the initial contract must combine the static fields (almost complete portions) and dynamic fields (the blank portions) at runtime (when the contract is sent to other party). The examiner further wishes to state that it is clear that the static

portions are already filled before they are sent to the negotiating party since they are the complete portions of the contract template.

Applicant goes on to argue on page 29, that **"the Applicants provide for filling the empty tags of the dynamic structure with business data values...Dan does not teach how to break an XML transaction and classify the static and dynamic components...The second phase occurs every time a transaction is sent to a partner, wherein the dynamic structures are automatically filled based on the associated pre-defined business logic"**. However, the examiner wishes to point to Paragraph 35 of **Dan** which states "Negotiable 1023 or 1024 may be treated as a blank that me completed by the negotiating party" (Paragraph 35). The examiner further wishes to state that the claim limitation merely reads as "filling empty tags of said dynamic structures with business data values". The examiner further wishes to state **Dan** clearly fills these values when the negotiating party fills in these blank fields. Moreover, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "The second phase occurs every time a transaction is sent to a partner, wherein the dynamic structures are automatically filled based on the associated pre-defined business logic") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant goes on to argue on page 30, that **"the Applicants provide for creating a copy of a pre-defined data type definition format comprising the XML**

format...the Applicants use the DTD to validate the final XML after the combining static and dynamic structures, and filling...the manner of comparison and validation is different between Thomas and the Applicants' claimed invention". However, the examiner wishes to point to Paragraph 38 of **Thomas** which states "the processor reads 12 the document type definition (DTD) of the first XML file and creates a copy 13 of the DTD" (Paragraph 38). The examiner further wishes to state that the claim limitation merely reads as "creating a copy of said original pre-defined data type definition format for said XML transaction". The examiner further wishes to state **Thomas** clearly creates a copy of a DTD.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. PGPUB 2002/0042782 issued to **Albazz et al.** on 11 April 2002. The subject matter disclosed therein is pertinent to that of claims 1-6, 8-16, and 18-24 (e.g., methods to generate b2b contracts).

U.S. PGPUB 2005/0005116 issued to **Kasi et al.** on 06 January 2005. The subject matter disclosed therein is pertinent to that of claims 1-6, 8-16, and 18-24 (e.g., methods to generate b2b contracts).

U.S. PGPUB 2006/0059024 issued to **Bailey et al.** on 16 March 2006. The subject matter disclosed therein is pertinent to that of claims 1-6, 8-16, and 18-24 (e.g., methods to generate b2b contracts).

U.S. PGPUB 20020138399 issued to **Hayes et al.** on 26 September 2002. The subject matter disclosed therein is pertinent to that of claims 1-6, 8-16, and 18-24 (e.g., methods to generate b2b contracts).

U.S. PGPUB 20020091533 issued to **Ims et al.** on 11 July 2002. The subject matter disclosed therein is pertinent to that of claims 1-6, 8-16, and 18-24 (e.g., methods to generate b2b contracts).

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mahesh Dwivedi whose telephone number is (571) 272-2731. The examiner can normally be reached on Monday to Friday 8:20 am – 4:40 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached (571) 272-3642. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mahesh Dwivedi

Patent Examiner

February 02, 2007

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